



396.43422X00

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Applicants: T. KOYAMA, et al.
Application No.: 10/765,167
Filed: January 28, 2004
For: POLYISOCYANATE COMPOUND, PROCESS FOR
PRODUCING THE COMPOUND, POLYADDITION
COMPOSITION AND POWDER COATING MATERIAL
Group: 1711
Examiner: R. F. Gorr
Confirm. No.: 2127

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 16, 2005

Sir:

In response to the Office Action mailed April 15, 2005, Applicants respectfully elect the Group III claims (that is, claims 7-9 and 11-16), which the Examiner contends are drawn to a powder coating composition comprising the pre-polymer. This election is made with traverse, in view of the following.

Initially, the undersigned notes that the Examiner contends that claims 1-3 are drawn to a uretdione. However, it is respectfully submitted that claims 2 and 3 are directed to a process for producing the polyisocyanate compound of claim 1. To clarify the record, it is respectfully requested that the Examiner indicate that claims 2 and 3 are directed to a process.

As for the restriction requirement, note that claim 1 defines a polyisocyanate compound obtained by converting a specific compound into a urethodione compound; claim 4 recites a polyisocyanate polyaddition composition obtained by reacting the compound of claim 1 and another (specified) compound; and claim 7

recites a powder coating material which includes at least one main material and a curing agent which includes the polyisocyanate polyaddition composition of claim 4. That is, claims 1, 4 and 7 require use of the polyisocyanate compound of claim 1. It is respectfully submitted that in view thereof, it would not constitute an undue burden on the Examiner to consider all of the claims presently pending in the above-identified application, therein. See Manual of Patent Examining Procedure (MPEP) 803.

Contentions by the Examiner in the last full paragraph on page 2 of the Office Action mailed April 15, 2005, are noted. However, the Examiner has provided no evidence supporting the contentions that the intermediate product I is deemed to be useful as a component for a fully reacted polyurethane, and that the intermediate product II is deemed useful as a moisture curable adhesive. Absent evidence in support of the contentions by the Examiner, it is respectfully submitted that such contentions must fail. Cf. In re McKellin, 188 USPQ 428 (CCPA 1976).

In view of all the foregoing, reconsideration and withdrawal of the restriction requirement set forth in the Office Action mailed April 15, 2005, and examination of all claims presently pending in the above-identified application, therein, are respectfully requested. In any event, Applicants respectfully elect the Group III claims, that is, claims 7-9 and 11-16, with traverse, and respectfully request that at least the Group III claims be considered on the merits in the above-identified application, in due course.

Please charge any shortage in fees due in connection with the filing of this paper, including any extension of time fees, to Deposit Account No. 01-2135 (Case 396.43422X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in black ink, appearing to read "William I. Solomon", written over a horizontal line.

William I. Solomon
Registration No. 28,565

WIS/ksh
1300 N. 17th Street
Suite 1800
Arlington, VA 22209
Tel: 703-312-6600
Fax: 703-312-6666